

REMARKS

Claims 1-13 were originally filed in the present application. Claim 2 has been previously cancelled, and Claims 14-16 were previously added, making Claims 1 and 3-16 at issue. Of the remaining claims, Claims 1 and 14-16 have been amended. The term “automatically” has been added to the step of “retrieving said document information” as set forth in each of the independent claims. As discussed below, Bailey does not automatically retrieve document information on related categories. At best, Bailey teaches an additional search step to acquire “related product” information. Support for this amendment can be found in the present application at paragraph 35 and elsewhere. No new matter has been added.

The Office Action of June 10 (hereinafter “Action”) has rejected Claims 1 and 3-16 under 35 U.S.C. 103(a) as unpatentable over U.S. Patent No. 6,740,729 to Klein et al. (hereinafter “Klein”) in view of U.S. Patent No. 6,785,671 to Bailey (hereinafter “Bailey”). Applicant respectfully traverses this rejection and requests reconsideration in light of the amendments above and the remarks below.

Under §103, “[a] patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which [it] pertains.” 35 U.S.C. 103(a).

Claims 1 and 14-16 are each independent, with Claims 3-13 depending from Claim 1. Independent claims 1 and 14, as amended, require the steps of “associating said initial search term to all topical categories related to said initial topical category” and “automatically retrieving” document information of documents assigned to related categories. Claims 15 and

16, as amended, require the steps of “associating the initial search term to any topical categories related to said initial topical category” and “automatically retrieving” document information of any documents assigned to any related categories, either “irrespective of a relevancy” (Claim 15) or including those documents “which are not relevant” (Claim 16).

The current Action acknowledges that Klein does not disclose “associating said initial search term to all topical categories related to said initial topical category. . . .” The Action says nothing about Klein disclosing the step of automatically retrieving document information on documents assigned to related categories irrespective of their relevancy or which are not relevant. Accordingly, such a step must therefore be found in Bailey, and a motivation must exist or a teaching provided which would lead one of skill in the art to combine the teachings to achieve the present invention. For a rejection based on a combination of prior art references, the examiner has the burden of showing “some teaching, suggestion, or motivation to combine the references.” *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998) (obviousness rejection reversed because examiner failed to show motivation to combine references); *see also Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, 411 F.3d 1332 (Fed. Cir. 2005); *In re Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002). The Examiner has failed to provide such showing here, except to say “it would have been obvious to a person of ordinary skill in the art....”

In order to support a conclusion that a claim is directed to obvious subject matter, the cited references must impliedly suggest the invention ***described by the claim***, or the Examiner must present a convincing line of reasoning as to why an artisan would have found ***the claimed invention*** obvious in light of the teachings of the cited references. *See In re Lee*, 277 F.3d at 1343; *Ex Parte Clapp*, 227 U.S.P.Q. 972 (PTO Bd. App. 1985). “[T]he mere fact that the prior

art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.” *In re Laskowski et. al.*, 10 U.S.P.Q. 2d 1397, 1398, (Fed. Cir. 1989), *citing In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). In discussing the mandate of 35 U.S.C. §103, the Federal Circuit has held that “it is the invention as a whole that must be considered in obviousness determinations. The invention as a whole embraces the structure, its properties and the problem it solves.” *In re Wright*, 6 U.S.P.Q. 2d 1959 (Fed. Cir. 1988). To combine the teachings of Klein and Bailey would require an inordinate amount of hindsight and redesign. Rather, the only suggestion of these features is found in the present application and while, in hindsight, it may now appear to be simple or elementary, that is not the test for obviousness or nonpatentability. *Crown Operations, Ltd. v. Solution, Inc.*, 289 F.3d 1367, 1376 (Fed. Cir. 2002) (“Determination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention.”); *see also In re Laskowski*, 10 U.S.P.Q.2d 1397, 1399 (Fed. Cir. 1989); *In re Rouffet*, 149 F.3d at 1357-58.

The claimed method is not, however, an invention where one reference can possibly disclose the first 10 steps and a second reference the next three steps. Rather, the claimed steps are a logical progression to achieve an end result, with each step reliant on the presence and completion of the previous step. For example, with respect to Claim 1, the step of “retrieving said document information . . . assigned to said related categories” is dependent upon first creating *related categories*. In order to create *related categories*, the reference must disclose “associating said initial search term to all topical categories related to said *initial topical category*. . . .” However, in order to do this step the reference must first create an *initial topical*

category. To create the *initial topical category*, the reference must associate “said initial search term with the topical category assigned to said *matched search term*. . . .” The *matched search term* is created by the step of “matching said initial search term with at least one said *anticipated search term* contained within said anticipated search term database. . . .” And so the process goes.

Said another way, if a reference does not teach the first step—“providing a topical category” in the case of Claim 1—then it cannot teach the second step, which depends on the presence of the first step. The Action, ignoring this logical progression and attempting to improperly piece together two references, admits by its stated rejection that neither reference teaches all the required steps of the claimed invention.

Klein teaches a method of retrieving relevant information categories. The system disclosed in Klein contains a database having a plurality of categories, which are inter-related in a familial structure. After the system receives a user search query, in the form of a search term query, a category most relevant to the user search query is selected and designated the “seed category.” (Klein, Col. 8, lines 51-55). The system then builds a cluster of ancestor and descendent categories around the seed category. (Klein, Col. 10, lines 37-39). The cluster of ancestor and descendent categories may include a grandparent, parent, child and sibling, or any combination thereof. (Klein, Col. 10, lines 40-42). Klein only selects and displays individual categories of the cluster of categories based upon the individual categories’ relevance with the queried search term. (Klein, Col. 12, lines 36-42). Accordingly, each category that is displayed in Klein must be relevant to the queried search term. (Klein, Col. 10, line 66 - Col. 11, line 2; Col. 12, lines 55-57).

Bailey is directed to a search engine system used to find internet web pages from which user-specified products can be purchased. (Bailey, Abstract). Bailey discloses a collection of databases (i.e., categories) which contain data tables indexed by keyword to facilitate searching in response to queries. However, Bailey is focused on prioritizing or ranking categories based on the significance of each category to the search query submitted by the user. (Bailey, Col. 5, lines 21-25). Bailey does not teach relating the topical categories (e.g., Books, Music, Video) with other topical categories as required by each independent claim. That is, instead of deriving a topical category containing documents from the initial user query and then pulling all related topical categories, Bailey performs a search in each topical category (i.e., each database) to derive relevant documents. This comes into play when the Action contends Bailey discloses “associating said initial search term to all topical categories related to said initial topical category thereby creating related categories.” The system of Bailey never relates the topical categories and, therefore, cannot create related categories. Accordingly, Claims 1 and 14 distinguish over both Klein and Bailey, either alone and in combination.

The Action appears to equate Bailey’s use of the term “related products” to the present invention’s creation of “related categories.” However, these are completely unrelated terms. The “Related Products” search of Bailey “does not take place simultaneously with the searches of the other databases 141-146.” (Bailey, Col. 9, lines 29-34). Instead, the “search is initiated by the user’s selection of the Related Products hypertext link 380, instead of by the user’s selection of the search initiation button 240.” (Bailey, Col. 9, lines 34-37). Requiring this extra step, Bailey cannot be said to teach the step of “automatically retrieving” as set forth in each of the

independent claims. Because Bailey never relates the topical categories to one another within a topical database, the categories must be operated and searched separately for every user query.

Further, Claim 15 and 16 retrieve document information irrespective of the relevancy between the initial search term and the related categories, and including categories which are not relevant to the initial search term. Bailey is directed to assessing relevance of each category to the search query by use of the approach known as “term frequency inverse document frequency” or TFIDF. (Bailey, Col. 5, lines 21-45). Even if other approaches are used (they are not disclosed), the clear teaching is that the relevance of categories is based on the user’s search query (see Bailey, col. 20, line 61 through col. 24, line 43). Accordingly, Claims 15 and 16 distinguish over both Klein and Bailey, either alone or in combination.


No combination of the cited references could suggest the claimed features of the present application, as the Examiner alleges. *See In re Rouffet*, 149 F.3d at 1356 (differences between the combined prior art and the claimed invention cannot show a *prima facie* case of obviousness). The only suggestion of these features is found in the present application and while, in hindsight, it may now appear to be simple or elementary, that is not the test for obviousness or non-patentability. *Crown Operations, Ltd. v. Solution, Inc.*, 289 F.3d at 1376 (“Determination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention.”); *see also In re Laskowski*, 10 U.S.P.Q.2d 1397, 1399 (Fed. Cir. 1989); *In re Rouffet*, 149 F.3d at 1357-58. Accordingly, Applicant contends that Claims 1 and 14-16, and the claims that depend therefrom, distinguish over Klein and Bailey, either considered alone or in combination. Reconsideration is respectfully requested.

CONCLUSION

Claims 1 and 3-16 are currently pending in the present application. All claims have been finally rejected as unpatentable under 103(a) over Klein in view of Bailey. Claims 1 and 14-16 have been amended herein. No new matter has been added. Each of the pending claims is believed to now be in condition for allowance. Reconsideration of all claims is respectfully requested.

If any informalities remain which can be addressed by Examiner's Amendment, Applicant request that the undersigned be contacted in order to expedite the present application.

Respectfully submitted,

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